

French arbitration clause blocks UDRP complaint against regional media company

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- The complainant, publisher of *L'Officiel* magazine and owner of several L'OFFICIEL marks, sought the transfer of 'lofficielearabia.com' under the UDRP
- The panel found that the question of whether the licence agreement between the parties was validly terminated by the complainant was not suitable for determination under the UDRP
- The respondent had registered the domain name with the legitimate intention of using it in connection with its licensed publication of *L'Officiel* magazine

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a three-member panel has denied a complaint for the disputed domain name 'lofficielearabia.com', finding that determination of the dispute between the parties fell outside the scope of the UDRP, citing a French arbitration clause as providing the preferred route for determination of the dispute.

Background

The complainant was Les Éditions Jalou, a French company engaged in the publishing and distribution of fashion magazines, including *L'Officiel*, which was first published in Paris in 1921. The complainant was the owner of a number of L'OFFICIEL-formative trademarks, including Bahrain trademark registration No 1/046099, registered on 3 June 2008.

The registered owner of the disputed domain name was an individual, the owner and authorised representative of a UAE company named Chalk Media FZE. The disputed domain name was registered on 10 April 2018. In June 2018 the parties entered into a licence agreement relating to the distribution of the complainant's *L'Officiel* magazine in Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and the United Arab Emirates. The disputed domain name was used to publish content originating from, and expressly associated with, the complainant's *L'Officiel* magazine. According to the complainant, the licence agreement was duly terminated by notice dated 11 February 2021. This was disputed by the respondent.

In order to prevail, a complainant must demonstrate, on the balance of probabilities, that it has satisfied the requirements of Paragraph 4(a) of the UDRP:

(i) the disputed domain name is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;

(ii) the respondent has no rights or legitimate interests in the disputed domain name; and

(iii) the disputed domain name was registered and is being used in bad faith.

Decision

Paragraph 4(a)(i)

The panel found that the complainant had established trademark rights for marks including L'OFFICIEL, both by itself and together with other elements. The panel observed that the disputed domain name incorporated the complainant's trademark, omitting the apostrophe, together with the term 'arabia', finding the disputed domain name to be confusingly similar to trademarks in which the complainant had rights.

Paragraph 4(a)(ii)

The panel noted that the question of whether the respondent had rights or legitimate interests in respect of the disputed domain name was "inextricably tied to the question of whether or not the licence agreement was validly terminated by the complainant", further noting that that question was disputed between the parties and was not, in the panel's view, suitable for determination within the confines of the UDRP.

As regards the ongoing contractual dispute between the parties, the panel commented that:

1. there was a dispute concerning the applicable facts;
2. the licence agreement was stated to be governed and construed in accordance with the laws of France;
3. the respondent had relied on a *force majeure* clause in the licence agreement, which would require both a factual determination as well as a legal determination of what amounted to *force majeure* under French law; and
4. the licence agreement expressly provided for the settlement of disputes arising out of, or in connection with, the licence agreement through arbitration in compliance with the rules of a designated French arbitration body.

The panel held that it was not in a position to make determinations on the above-listed matters, their determination falling outside of the scope of the UDRP, and that it was therefore unable to determine whether the respondent had rights or legitimate interests in respect of the disputed domain name. Noting that it was impossible for the complainant to establish that the respondent had no rights or legitimate interests in respect of the domain name, the complaint would therefore fail.

Paragraph 4(a)(iii)

The panel went on to observe that the disputed domain name had been registered with the complainant's knowledge, and that the complainant had assisted the respondent with its website at the disputed domain name in 2018. The panel commented in this regard that there was no evidence of the respondent having registered the disputed domain name with any intention of infringing the rights of the complainant. Rather, the respondent had registered the domain name with the legitimate intention of using it in connection with its licensed publication of the complainant's *L'Officiel* magazine. The panel found that the complainant had failed to establish that the respondent registered the disputed domain name in bad faith; therefore, the complaint would also fail on the third element of the UDRP.

Comment

It is often said that the UDRP was intended for clear, so-called 'slam-dunk' cases of trademark-abusive domain name registration and use. In cases involving pre-existing agreements between parties to a UDRP dispute, particularly those involving agreements that include clauses prescribing specific mechanisms for determining disputes between contractual parties, UDRP panels will be careful not to make determinations that would pre-empt the findings of the competent dispute resolution body

as determined in the respective contract. In many of such cases, it is often the case that the domain name in question forms part of a broader business dispute not limited to the domain name itself, which would not be suitably determined by the mere transfer or cancellation of the domain name. Such cases typically require determinations on legal and factual matters falling outside the relatively narrow grounds of the UDRP, and are better suited to resolution in a court of competent jurisdiction with the benefit of discovery, interrogatories and witness testimony.

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